

1 **CALDARELLI HEJMANOWSKI & PAGE LLP**

2 William J. Caldarelli (SBN #149573)

3 Ben West (SBN #251018)

4 12340 El Camino Real, Suite 430

5 San Diego, CA 92130

6 Telephone: (858) 720-8080

7 Facsimile: (858) 720-6680

8 [wjc@chplawfirm.com](mailto:wjc@chplawfirm.com)

9 [dbw@chplawfirm.com](mailto:dbw@chplawfirm.com)

10 **FABIANO LAW FIRM, P.C.**

11 Michael D. Fabiano (SBN #167058)

12 12526 High Bluff Drive, Suite 300

13 San Diego, CA 92130

14 Telephone: (619) 742-9631

15 [mdfabiano@fabianolawfirm.com](mailto:mdfabiano@fabianolawfirm.com)

16 **OSBORNE LAW LLC**

17 John W. Osborne (*Appointed Pro Hac Vice*)

18 33 Habitat Lane

19 Cortlandt Manor, NY 10567

20 Telephone: (914) 714-5936

21 [josborne@osborneipl.com](mailto:josborne@osborneipl.com)

22 **WATTS LAW OFFICES**

23 Ethan M. Watts (SBN #234441)

24 12340 El Camino Real, Suite 430

25 San Diego, CA 92130

26 Telephone: (858) 509-0808

27 Facsimile: (619) 878-5784

28 [emw@ewattslaw.com](mailto:emw@ewattslaw.com)

29 Attorneys for Plaintiff Ameranth, Inc.

30 ///

31 ///

32 ///

33 **SUPPLEMENTAL REQUEST FOR JUDICIAL NOTICE ISO PLAINTIFF**  
34 **AMERANTH, INC.'S MOTION TO DISMISS DEFENDANTS'**  
35 **INEQUITABLE CONDUCT COUNTERCLAIMS AND AFFIRMATIVE**  
36 **DEFENSES** CASE NO. 11-cv-01810-DMS-WVG

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA**

## AMERANTH, INC.,

Plaintiff,

V.

PIZZA HUT, INC., ET AL.,

## Defendants

Civil Action No.: 3:11-cv-01810-DMS-WVG

Consolidated with:

12cv729 DMS-WVG	12cv1640 DMS-WVG
12cv731 DMS-WVG	12cv1642 DMS-WVG
12cv732 DMS-WVG	12cv1643 DMS-WVG
12cv733 DMS-WVG	12cv1644 DMS-WVG
12cv737 DMS-WVG	12cv1646 DMS-WVG
12cv739 DMS-WVG	12cv1648 DMS-WVG
12cv742 DMS-WVG	12cv1649 DMS-WVG
12cv858 DMS-WVG	12cv1650 DMS-WVG
12cv1627 DMS-WVG	12cv1651 DMS-WVG
12cv1629 DMS-WVG	12cv1652 DMS-WVG
12cv1630 DMS-WVG	12cv1653 DMS-WVG
12cv1631 DMS-WVG	12cv1654 DMS-WVG
12cv1633 DMS-WVG	12cv1655 DMS-WVG
12cv1634 DMS-WVG	12cv1656 DMS-WVG
12cv1636 DMS-WVG	

**SUPPLEMENTAL REQUEST FOR  
JUDICIAL NOTICE IN SUPPORT OF  
PLAINTIFF AMERANTH, INC.'S MOTION  
TO DISMISS DEFENDANTS'  
INEQUITABLE CONDUCT  
COUNTERCLAIMS AND AFFIRMATIVE  
DEFENSES**

## AND RELATED CASES.

1 Plaintiff Ameranth, Inc. (“Ameranth”) hereby requests the Court to take  
 2 judicial notice of: (1) the Information Disclosure Statement (“IDS”) filed by  
 3 Ameranth with the USPTO on October 1, 2010, in connection with Pat. App.  
 4 11/112,990; and (2) the USPTO Patent Examiner’s acknowledgement and sign-off  
 5 of the IDS dated December 12, 2011 prior to the issuance of the Notice of  
 6 Allowance for the ‘077 Patent. Judicial notice is requested in connection with  
 7 Ameranth’s various pending motions to dismiss several defendants’ inequitable  
 8 conduct counterclaims and affirmative defenses.

9 **DISCUSSION**

10 Ameranth previously filed several motions to dismiss various counterclaims  
 11 and affirmative defenses asserted by defendants Seamless, OpenTable, Domino’s,  
 12 GrubHub, O-Web, Papa John’s, Pizza Hut and QuikOrder alleging inequitable  
 13 conduct in connection with the prosecution of Ameranth’s ‘077 Patent.

14 Recently, in the parties’ Joint Preliminary Report Re Ameranth Patent  
 15 Litigation submitted to the Court on September 9, 2013 (the “Joint Report”), the  
 16 defendants represented to the Court that Ameranth purportedly failed to disclose to  
 17 the USPTO Examiner for the ‘077 Patent (previously Pat. App. 11/112,990) certain  
 18 supposed “prior art” references that had been identified by the Examiner for a  
 19 different Ameranth patent application currently pending before the BPAI at the  
 20 USPTO (Pat. App. No. 11/190,633)(the “‘633 Application”), and the ‘633  
 21 Application Examiner’s reasoning. See Joint Report, at p. 28, ll. 17-21.

22 Defendants’ representation is incorrect, as demonstrated by the IDS filed by  
 23 Ameranth with the USPTO in connection with prosecution of the ‘077 Patent (Pat.  
 24 App. 11/112,990) on October 1, 2010. See Notice of Lodgment (“NOL”), Exhibit  
 25 1. Ameranth requests the Court to take judicial notice of the IDS, as explained

1 herein, and the USPTO Examiner’s subsequent “sign-off” of the items submitted  
 2 with the IDS (NOL, Exh. 2).

3 In the Ameranth v. Menusoft trial in the Eastern District of Texas, Case No.  
 4 2:07-cv-0271, the defendants included the entire file history for the ‘633  
 5 Application in their trial exhibits. See NOL, Exh. 1 at p. 0012, item 8 (“Certified  
 6 Copies of File History for U.S. Patent Application 11/190,633”). Along with the  
 7 October 1, 2010 IDS filed with the USPTO in connection with the prosecution the  
 8 ‘077 Patent (Pat. App. 11/112,990), Ameranth submitted the Menusoft defendants’  
 9 trial exhibit lists-- *the list of exhibits includes the Patent Application file number*  
 10 *and file history for the ‘633 Application.* NOL, Exh. 1 at p. 0012, item 8.

11 In the IDS, Ameranth specifically noted that all of the items listed “are made  
 12 of record herein, and the Examiner’s attention is directed to each of the items listed  
 13 on Form PTO/SB/08a.” NOL, Exh. 1 at p. 0004. The Examiner was further  
 14 expressly invited to contact Ameranth’s counsel if the Examiner wanted to request  
 15 any additional materials from the Menusoft lawsuit. NOL, Ex. 1, at p. 0004.

16 On December 16, 2011, the Examiner for the ‘077 Patent (Pat. App.  
 17 11/112,990), Matthew Brophy, initialed and signed off on the IDS, confirming that  
 18 he had considered the disclosed items, including the file history for the ‘633  
 19 Application (the ‘077 Patent issued a few months later, on March 27, 2012). NOL,  
 20 Ex. 2. Importantly, by December of 2011, when the Examiner for ‘077 Patent  
 21 considered and signed off on the IDS, including the ‘633 Application file disclosed  
 22 therein and all matters of record on file through that date, the ‘633 Application file  
 23 contained all of the supposed “prior art” references and reasoning identified and  
 24 relied upon by the Examiner for the ‘633 Application and which form the basis for  
 25 defendants’ inequitable conduct claims in this litigation.

The IDS thus disclosed to the Examiner for the ‘077 Patent all of the references identified by the Examiner for the ‘633 Application as well as the ‘633 Application Examiner’s reasoning and determinations. Consequently, all such references were, in fact, disclosed by Ameranth to the USPTO in connection with the prosecution of the ‘077 Patent, and no counterclaim or affirmative defense for inequitable conduct based on the supposed concealment of such references from the USPTO can survive<sup>1</sup>. Defendants’ representations to the contrary are incorrect. See Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1582 (Fed. Cir. 1991) (overruled on other grounds by Abbott Labs. v. Sandoz, Inc., 566 F.3d 1282 (Fed. Cir. 2007)) (“The Meyer abstract was before the patent examiner who, according to Genentech, discovered it “on his own.” When a reference has been considered by the examiner, it is not controlling how it came to the examiner’s attention. The complete Meyer paper, and several other references, cited the Meyer abstract. Genentech argues that Scripps should nonetheless have brought the Meyer abstract to the examiner’s specific attention, in addition to having listed the complete Meyer paper in Scripps’ prior art statement. When a reference was before the examiner, whether through the examiner’s search or the applicant’s disclosure, it cannot be deemed to have been withheld from the examiner.”); Young v. Lumenis, Inc., 492 F.3d 1335, 1349-50 (Fed. Cir. 2007)(no inequitable conduct for failure to disclose material information where such

<sup>1</sup> Ameranth has previously explained that it sincerely believes that the references identified by the Examiner for the '633 Application are not relevant or material to the distinct claims of the '077 Patent, including the '077 Examiner's added "but for" limitations, and/or are cumulative to references that were already before the Examiner for the '077 Patent, defeating any allegation of intent to deceive the USPTO. The fact that the file history for the '633 Application was, nonetheless, disclosed to the Examiner for the '077 Patent and signed off by him independently and conclusively defeats any assertion of inequitable conduct or failure to disclose.

1 information was disclosed to the PTO in time for the examiner to consider it,  
2 although only after the issue of disclosure was raised in a parallel district court  
3 action).

4 Despite the disclosure of the '633 Application file by Ameranth to the  
5 Examiner of the '077 Patent, the USPTO issued the '077 Patent on March 27,  
6 2012.

7 Ameranth therefore requests the Court to take judicial notice under Rule 201  
8 of the Federal Rules of Evidence of: (1) the IDS filed by Ameranth with the  
9 USPTO on October 1, 2010 disclosing the '633 Application file, inclusive of the  
10 references, reasoning and determinations therein; and (2) Examiner Matthew  
11 Brophy's acknowledgement and "sign off" of the IDS dated December 12, 2011.  
12 True and correct copies of excerpts of the October 1, 2010 IDS reflecting the  
13 disclosure of the '633 Application and the December 12, 2011 Examiner "sign-off"  
14 of the IDS are attached as Exhibits 1 and 2 to the Notice of Lodgment filed  
15 herewith.

16 Dated: September 13, 2013 CALDARELLI HEJMANOWSKI & PAGE LLP

17 By: /s/ William J. Caldarelli

18 William J. Caldarelli

19 Ben West

20 FABIANO LAW FIRM, P.C.

21 Michael D. Fabiano

22 OSBORNE LAW LLC

23 John W. Osborne

24 WATTS LAW OFFICES

25 Ethan M. Watts

26 **Attorneys for Plaintiff Ameranth, Inc.**